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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,043	05/11/2001	Dwayne Yount	40204	5072

7590 01/15/2003

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EXAMINER

SOHN, SEUNG C

ART UNIT

PAPER NUMBER

2878

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 09/853,043	Applicant(s) YOUNT ET AL.	
	Examiner Seung C. Sohn	Art Unit 2878	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 and 28-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 18-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2001 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6 &amp; 7</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of claims 1-10 and 18-27 in Paper No. 7 dated on November 1, 2002 is acknowledged. The traversal is on the ground(s) that "the subject matter of all species is sufficiently related that a through search for the subject matter of elected species would encompass a search for the subject matter of the remaining species". This is not found persuasive because the Election of Species requirement issued on October 3, 2002 is based on the fact that the claimed invention has patentably distinct species, not the criteria under MPEP 803.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Furthermore, the fact that search for two inventions overlaps does not necessarily eliminate a serious burden in examining two different inventions. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 11-17 and 28-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species II, there being no allowable generic or linking claim.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "142-162" have been used to designate different parts in Figs. 1-6. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because the label "CHANNEL DAG" in data acquisition modules (208) in Figs. 11 and 12 should be -- CHANNEL DAQ --. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors (e.g., page 23, paragraph 0078, last line, "-Accordingly"). Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**7. *Claims 1-10 and 18-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Bierhoff (Patent No. US 4,813,031).***

**Referring to claim 1**, Bierhoff shows in Fig. 1 the following elements of

Applicant's claim:

a) a sampling device (15, i.e., A/D converter), adapted to receive portions of said signal (A') from said detector (11a) in time sequence (17, i.e., clock-signal generating circuit) and to generate a respective value (A) representative of the respective magnitude of each respective portion of said signal as said respective portion of said signal is being received (Col. 3, lines 43-57); and

b) a storage device (32, i.e. hold circuit), adapted to store said values generated by said sampling device (15) (Col. 4, lines 61-66).

**Referring to claim 2**, Bierhoff discloses that said sampling device (15) receives a number of said portions totaling substantially all of said signal, and generates said values which represent said portions of substantially all of said signal (Col. 1, lines 47-51).

**Referring to claim 3**, Bierhoff discloses that said signal is an analog signal representative of a light signal emitted from said event as detected by said detector (11a) (Col. 3, lines 52-54).

**Referring to claim 4**, Bierhoff discloses an arithmetic device (37, i.e., processing circuit), adapted to arithmetically combine a designed value (a bar) with each of said values (Col. 5, lines 13-15).

**Referring to claim 5**, Bierhoff shows in Fig. 4 that said arithmetic device (37) includes a subtractor (69 & 70) which is adapted to subtract said designated value from each of said values (Col. 6, lines 49-51).

**Referring to claim 6**, Bierhoff discloses that said designated value (a bar) is representative of an undesired signal detected by said detector (11a) (Col. 5, lines 1-8).

**Referring to claim 7**, Bierhoff discloses that said designated value (a bar) is representative of a characteristic of said detector (11a) (Col. 5, lines 9-12).

**Referring to claim 8**, Bierhoff shows in Fig. 1 that

a) said sampling device (15) is adapted to receive portions of a second said signal (B') from a second said detector (11b) in time sequence and to generate a respective second value (B) representative of the respective magnitude of each receptive portion of said second signal as said respective portion of said second signal is being received (Col. 3, lines 43-57); and

b) said storage device (34, i.e., hold circuit) is adapted to store said second values (B) generated by said sampling device (15) (Col. 4, lines 61-66).

**Referring to claim 9**, Bierhoff discloses that said sampling device (15) receives said portions of said signal at a time different from that during which said sampling device (15) receives at least some of said portions of said second signal.

**Referring to claim 10**, Bierhoff shows in Fig. 1 that a comparator (56), adapted to compare each of said second values (B) with a receptive one of said first values (A) to compare said signal to said second signal (Col. 7, lines 18-39).

**Referring to claim 18**, Bierhoff shows in Fig. 1 the following elements of Applicant's claim:

- a) receiving portions of said signal (A') from said detector (11a) in time sequence;
- b) generating a respective value (A) representative of the respective magnitude of each respective portion of said signal as said respective portion of said signal is being received (Col. 3, lines 43-57); and
- c) storing said values (Col. 4, lines 61-66).

**Referring to claim 19**, Bierhoff discloses that said receiving receives a number of said portions totaling substantially all of said signal; and said generating generates said values which represent said portions of substantially all of said signal (Col. 1, lines 47-51).

**Referring to claim 20**, Bierhoff discloses that said signal is an analog signal representative of a light signal emitted from said event as detected by said detector (Col. 3, lines 52-54).

**Referring to claim 21**, Bierhoff discloses arithmetically combining a designated value with each of said values (Col. 5, lines 13-15).

**Referring to claim 22**, Bierhoff discloses that said arithmetic combining includes subtracting said designated value from each of said values (Col. 6, lines 49-51).

**Referring to claim 23**, Bierhoff discloses that said designated value (a bar) is representative of an undesired signal detected by said detector (Col. 5, lines 1-8).

**Referring to claim 24**, Bierhoff discloses that said designated value is representative of a characteristic of said detector (Col. 5, lines 9-12).

**Referring to claim 25**, Bierhoff discloses that receiving portions of a second said signal from a second said detector in time sequence; generating a respective second value representative of the respective magnitude of each respective portion of said second signal as said respective portion of said second signal is being received (Col. 3, lines 43-57); and storing said second values (Col. 4, lines 61-66).

**Referring to claim 26**, Bierhoff discloses that said receiving steps are performed such that said portions of said signal are received at a time different from that during which at least some of said portions of said second signal are received.

**Referring to claim 27**, Bierhoff discloses that comparing each of said second values with a respective one of said first values to compare said signal to said second signal (Col. 7, lines 18-39).

### ***Conclusion***

8. Claims 1-10 and 18-27 are rejected.
9. Claims 11-17 and 28-34 are withdrawn from consideration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seung C. Sohn whose telephone number is (703) 308-



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4093. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (703) 308-4852. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

SCS

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January 11, 2003



Kevin Pyo  
Primary Examiner